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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,490	11/15/2001	Keiji Komoto	684.3260	7263
5514	7590	10/21/2004		
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER DOTE, JANIS L	
			ART UNIT 1756	PAPER NUMBER

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/987,490

Applicant(s)

KOMOTO ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached, paragraphs 1 and 2.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached, paragraph 3.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 48, 49, 51, 54-58, 61, 63, 64, and 67-73.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*Janis L. Dote*  
JANIS L. DOTE  
PRIMARY EXAMINER  
GROUP 1500  
1700

1. The proposed "Amendment to the specification" section in the amendment filed after the final rejection on Oct. 7, 2004, is not in compliance with 37 C.F.R. 1.121 for the following reasons:

(1) The proposed amended paragraph at page 91 does not unambiguously identify what paragraph on page 91 it is replacing. Applicants have not provided the line number identifying where the paragraph to be replaced is located on page 91.

37 CFR 1.121(b)(1) states that "[a]mendments to the specification . . . which are considered for amendment purposes to an amendment of a paragraph, must be made by submitting: (i) An instruction, which unambiguously identifies the location, to . . . replace a paragraph with one or more replacement paragraphs" (emphasis added).

(2) The amended paragraph beginning at page 191, line 26, filed on Oct. 7, 2004, is not in compliance with 37 CFR 1.121 because it tries to amend a paragraph that is not present in the specification. The originally filed paragraph beginning at page 191, line 26, was previously amended in the amendment filed on Apr. 27, 2004. The amended paragraph filed on Apr. 27, 2004, capitalized the word "Henschel," which is what the amended paragraph filed on Oct. 7, 2004, is trying to do.

37 CFR 1.121(b)(1)(ii) states that "[t]he full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of

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any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters . . . ." (emphasis added).

2. The proposed amendment to claim 48 in the amendment filed after the final rejection on Oct. 7, 2004, raises new issues that would require further consideration and/or a search for the following reasons:

The proposed amendment to claim 48 adds the limitations of dependent claims 54 and 61, and the limitation, "developing means including a magnetic toner" (emphasis added).

Each of claims 54 and 61 was dependent on claim 1. There was no claim present at the time the final office action was mailed that required the limitations recited in both claims 54 and 61 and required that the developing means include a magnetic toner. No claim was present at the time the final rejection was mailed that positively recited the presence of a magnetic toner in the apparatus. The issue that the apparatus claims did not positively recite the presence of the magnetic toner in the apparatus was raised by the examiner in the two previously mailed non-final rejections. See, for example, the first office action mailed on Mar. 3, 2002, paragraph 18, and the second

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office action mailed on Jan. 20, 2004, paragraphs 15, 18, and 20.

The subject matter recited in claim 54 was rejected over prior art and rejected in the final rejection under the doctrine of obvious-type double patenting rejection over the claims of US 6,576,387 B2 (Hashizume). See the final rejection mailed on Jul. 7, 2004, paragraphs 13, 15, 16, and 18. The subject matter recited in claim 61 was rejected in the final rejection over prior art and rejected under the doctrine of obvious-type double patenting over claims of US 6,596,452 B2 (Magome). See the final rejection mailed on Jul. 7, 2004, paragraphs 14 and 19.

The proposed amendment to claim 48 and claims dependent on claim 48 would raise an obvious-type double patenting rejection over the claims of US 6,596,452 B2 in view of US 6,040,103 (Ohno) and US 5,728,800 (Ohba), further in view of European Patent 989470 A2.

3. The examiner's refusal to enter the amendment filed after the final rejection on Oct. 7, 2004, renders applicants' arguments moot.